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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/671,059
Filing Date: September 25, 2003
Appellant(s): PATRICK, KYLE N.

Volel Emile
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/28/2007 appealing from the Office action mailed 4/27/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

Applicant has submitted an amendment on 12/21/2009, in response to the Notice of Non-Compliant Appeal Brief, dated 11/25/2009.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,103,634

Ullmann et al.

9-2006

(9) Grounds of Rejection

1. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Birrell et al. (US 6189026 B1) hereafter Birrell.

Regarding **claim 6**, Birrell discloses:

A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

i) storing said received e-mail message in the memory of said recipient computer; (“Mail messages are stored in message files of the mail service system” Abstract)

ii) parsing the contents of the said received email for e-mail addresses of the previous senders and recipients to form and forming a list of said parsed e-mail addresses;; (Col 12, lines 16-18 “the system heuristically locates text strings which have the syntax of email addresses”, it is inherent that previous senders of a chain email are also previous receivers)

iii) displaying said list of parsed e-mail addresses; (Col 12 lines 18-19 “if the user clicks on one of these addresses, inherently the list of addresses must be displayed in order for a user to click on them) and

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selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Col

12 lines 18-21 "If a user clicks on one of these addresses then the system will display a composition window so that the user can easily generate a reply message to the selected email address(es).

wherein said recipient computer parses said received e-mail message automatically upon receipt of said message. (Col. 7 lines 23-24 state that messages are processed in batches as they are received.)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ullmann et al. (US 7103634 B1) hereafter Ullmann.

As to claim 8, Ullmann discloses A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail

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message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

i) storing said received e-mail message in the memory of said recipient computer; (this step is inherent as the message must be stored in memory of the computer)

ii) parsing the contents of the said received email for e-mail addresses of the previous senders and recipients to form and forming a list of said parsed e-mail addresses;; (Col 8 lines 55-57 “scanning the attached or inline header fields of the original message”, it is inherent that the parsed email addresses will comprise both the previous senders and recipients if the inline header fields are all parsed.)

iii) displaying said list of parsed e-mail addresses; (the “special field” disclosed in line 54 would display the results of the scanning above) and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Figure 4 step 47 of fully incorporated application 09/672,181 shows that the built list of previous senders and recipients can be used to provide automatic addressing for a reply or forwarded message.)

wherein prior to said parsing step said user requests a list of potential reply e-mail addresses. (Col 10, when the user asks to make a reply message, the message is

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parsed in order to find possible reply candidates as inherently part of forming a reply requires a user to specify to whom the message is going to.

As to claim 9, Ullmann discloses A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

i) storing said received e-mail message in the memory of said recipient computer; (this step is inherent as the message must be stored in memory of the computer)

ii) parsing the contents of the said received email for e-mail addresses of the previous senders and recipients to form and forming a list of said parsed e-mail addresses;; (Col 8 lines 55-57 “scanning the attached or inline header fields of the original message”, it is inherent that the parsed email addresses will comprise both the previous senders and recipients if the inline header fields are all parsed.)

iii) displaying said list of parsed e-mail addresses; (the “special field” disclosed in line 54 would display the results of the scanning above) and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Figure 4 step 47 of fully incorporated application 09/672,181 shows that the built

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list of previous senders and recipients can be used to provide automatic addressing for a reply or forwarded message.)

wherein said response message is formed by auto-populating SMTP headers with said list of e-mail addresses (Col. 9 lines 18-22 disclose populating the reply-to field of the email automatically with the addresses found in the search of the email.)

As to claim 10, Ullmann discloses A method of selecting recipients of an e-mail message for transmission by a recipient computer in reply to a received e-mail message, the received e-mail message including a chain of previously sent e-mail messages wherein each previously sent e-mail message includes at least one previous sender and one previous recipient, the method comprising:

i) storing said received e-mail message in the memory of said recipient computer; (this step is inherent as the message must be stored in memory of the computer)

ii) parsing the contents of the said received email for e-mail addresses of the previous senders and recipients to form and forming a list of said parsed e-mail addresses;; (Col 8 lines 55-57 “scanning the attached or inline header fields of the original message”, it is inherent that the parsed email addresses will comprise both the previous senders and recipients if the inline header fields are all parsed.)

iii) displaying said list of parsed e-mail addresses; (the “special field” disclosed in line 54 would display the results of the scanning above) and

selecting, by the e-mail recipient, one or more of the e-mail addresses from the list to address the e-mail message, each selected e-mail address identifying a user to which the e-mail message is to be sent; and

iv) forming a reply e-mail message to recipients selected from said list by said user. (Figure 4 step 47 of fully incorporated application 09/672,181 shows that the built list of previous senders and recipients can be used to provide automatic addressing for a reply or forwarded message.)

wherein said response message is formed by auto-populating user interface graphical elements. (Col 10 lines 29-36 describes that the user is prompted to create an address book entry for a group, in which the group is automatically filled with addresses found in the search of the email.)

(10) Response to Argument

Regarding claim 6, Appellant argues that Birrell does not teach performing the step of parsing an e-mail message for e-mail addresses of previous senders and recipients as soon as the e-mail message is received.

As stated in the above rejection of claim 6 over Birrell, in Col. 7 lines 23-24 state that newly received messages are processed in batches as they are received. This means that as soon as it is received, the message is placed in a batch to be parsed by the parsing algorithm as described in the paragraph between lines 45-54 in col. 7.

Additionally, the Examiner notes that Appellant did not appeal the rejections of claims 16 and 26 under 35 U.S.C. 102(b) over Birrell, which contain essentially the same subject matter as claim 6, admitting the propriety of those rejections.

Regarding claim 8, Appellant argues that Ullmann does not disclose the step of requesting a list of potential reply e-mail addresses prior to parsing for e-mail addresses of the previous senders and recipients.

Ullmann discloses a request for potential reply e-mail addresses prior to parsing the e-mail in a few ways.

First, in Col. 8, lines 50-58, Ullmann states that after a user has send a request to forward an email, he is provided a list of possible recipients of the email -then- a special list of addresses generated by scanning the inlined header fields of the original message. Therefore, as the limitation of the claim requires, the message is “parsed” for reply e-mail addresses -after- a request for potential reply addresses. (The request to forward/reply to the message is a request for potential reply addresses.)

Secondly, in Col. 10, lines 20-52, it is described that after a user requests to make a new message, a reply message, or to forward a message, the previous email is scanned (i.e. parsed) for previous recipient and sender e-mail addresses.

Additionally, the Examiner notes that Appellant did not appeal the rejections of claims 18 and 28 under 35 U.S.C. 102(e) over Ullmann, which contain essentially the same subject matter as claim 8, admitting the propriety of those rejections.

Regarding claim 9, Appellant argues that Ullmann does not disclose auto-populating headers with the list of e-mail addresses.

As stated in the above rejection of claim 9 over Ullmann, Col. 9 lines 18-22 disclose the feature of populating headers of an e-mail message with the list of e-mail addresses. Tables 7 and 8 shows headers (SMTP headers, note especially Table 8,

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which places the list of e-mail addresses in the "Reply-to" header) that have the list of parsed email addresses within them.

Furthermore, in the process of sending the email, it is inherent in sending an email that at least the "To:" field of a e-mail message must be populated with the recipients of an email message.

Regarding claim 10, Appellant argues that Ullmann does not disclose auto-populating user interface graphical elements with the list of e-mail addresses.

As stated in the above rejection of claim 10 over Ullmann, Col. 10 lines 29-36 disclose this limitation. "He may also associate one or more of the found previous recipients and originators..." In order for a user to be able to perform the action of associating "one or more" of these addresses with the current email, it is inherent for the e-mail addresses to be displayed to the user for such a selection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Larry Donaghue/

Primary Examiner, Art Unit 2454

Conferees:

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Primary Examiner, Art Unit 2445

/Philip C Lee/

Primary Examiner, Art Unit 2448